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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,901	02/08/2002	Takatoshi Nishizawa	218129US2	8032
22850 7590 02/20/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER VO, HAI	
			ART UNIT	PAPER NUMBER
			1771	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/20/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/067,901

Applicant(s)

NISHIZAWA ET AL.

Examiner

Hai Vo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

1. All of the art rejections have been withdrawn in view of the declaration filed on 11/28/2006. The experimental data provided in the declaration have shown that the plastic films of the prior art failed to attain a surface potential in the range from -10 kV to +10 kV as set forth in the claims. However, new grounds of rejections are made in view of newly discovered references to Calhoun et al (US 6,569,527), Endo et al (US 5,932,3410), Cowell Senft (US 6,468,635) and Hatke et al (US 6,489,033).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, and 3-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear whether the charge potential and the attractive force are the physical properties of the presently claimed stretched film. The recitation "50g or less" implies that the attractive force could get to zero. Similarly, the range from "-10 kV to +10 kV" allows the stretched film to have zero charge potential.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by WO99/61521. Calhoun et al (US 6,569,527) will be relied on as an equivalent form of WO99/61521 for convenience. The recitation "50g or less" implies that the attractive force could get to zero. Similarly, the range from "-10 kV to +10 kV" allows the stretched film without charge potential. Therefore, a stretched film of a void-containing thermoplastic resin without charge potential would read on the claimed subject matter. Calhoun teaches a breathable film comprising a polyolefin resin and at least 10% by weight of inorganic filler (column 2, lines 45-50). The film is opaque (column 12, lines 1-3). The film is biaxially oriented (column 12, lines 40-45). The film has a porosity of 44.7% as shown in sample 2 of table 2. The porous film is useful as a packaging material for foods (column 13, lines 15-20). There is no application of the charge potential on the breathable film. The recitation "an in-mold-forming label" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d

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150, 152, 88 USPQ 478, 481 (CCPA 1951). Accordingly, Calhoun anticipates the claimed subject matter.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/61521 as applied to claim 1 above, and further in view of Sheth (US 4,777,073). Calhoun et al (US 6,569,527) will be relied on as an equivalent form of WO99/61521 for convenience. Calhoun does not teach the breathable film comprising an antistatic agent. Sheth, however, teaches a breathable film comprising a polyolefin resin composition that includes an antistatic agent (column 5, lines 40-45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an antistatic agent in the breathable film because such is a conventional additive being added to the polyolefin resin of the breathable film. Sheth provides necessary details to practice the invention of Calhoun.
8. Claims 1, and 3-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Endo et al (US 5,932,341). Endo teaches a biaxially oriented multilayered film comprising at least one layer of polyethylene terephthalate (PET) and at least one layer of copolymer polypropylene. The attractive force between two layers in the range of 0.1 to 20 g/cm (column 7, lines 30-35). The polypropylene layer comprises an antistatic agent and inorganic particles in an amount ranging from 0.01 to 5 wt% (column 5, lines 50-55, column 6, lines 65-67, and column 7, lines 1-5). The polypropylene layer has a surface potential of +5 kV (column 12, lines 5-10). Endo does not specifically disclose the porosity of the polypropylene layer. However, since the polypropylene layer

comprising inorganic particles has been subjected to orientation, it is not seen that the pores could not have been generated around the inorganic particles upon stretching. The amount of inorganic particles is used within the claimed range and particle size of the inorganic particles is within the range disclosed in the present disclosure. Therefore, it is examiner's position that the porosity and opacity would be substantially inherently present within the claimed ranges as the same material and the same stretching approach have been employed. Like material has like property. The recitation "an in-mold-forming label" or "a resin container" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Accordingly, Endo anticipates or strongly suggests the claimed subject matter.

9. Claims 1, 4, 5, 8, 10 and 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cowell Senft (US 6,468,635). Cowell Senft discloses a film comprising a printing layer and a blotting layer as shown in figure 4. The film is stretched and has a surface potential between 5 kV to 30 kV, which is within the claimed range (column 5, lines 10-15, and 25-27). The printing layer is porous and opaque (column 3, lines 30-32; and column 6, lines

35-40). The printing layer is of polypropylene (column 6, lines 18-20). The films do not stick together (column 6, lines 1-2). Likewise, the attractive force between the films would be inherently present in the claimed range. The recitation "an in-mold-forming label" or "a resin container" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Accordingly, Cowell Senft anticipates or strongly suggests the claimed subject matter.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cowell Senft (US 6,468,635). Cowell Senft teaches the porosity of the printing layer could be controlled as dependent on the particle dose level and subsequent etch duration (column 4, lines 10-13). Cowell Senft does not specifically disclose the porosity of the printing sheet. In view of the extremely wide range for the porosity and in the absence of evidence to the contrary, it is believed that it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the printing sheet having a porosity in the range instantly claimed motivated by the desire to provide sufficient ink absorbency to allow printing in inkjet printers.

11. Claims 1, 3-8, 10 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/56836. Hatke et al (US 6,489,033) will be relied on as an equivalent form of WO '836 for convenience. Hatke teaches a biaxially oriented electret film comprising a mixture of cycloolefin copolymer and polypropylene and silica (Syloblock) in an amount of 0.2 wt% (column 9, lines 45-50, table 1). The silica supplied by W. R. Grace, Davidson Chemical Division (Syloblock) has a 2-micron average particle size as evidenced by Wood, Jr. et al (US 6,599,383). Silica reads on Applicant's antistatic agent and inorganic filler as well. The electret film has a surface potential of 0.1 to 0.5 kV (column 7, lines 58-60). Hatke does not specifically disclose a porous electret film having a porosity of from 0.1 to 60%. However, since the electret comprising silica particles has been subjected to orientation, it is not seen that the pores could not have been generated around the silica particles upon stretching. The amount of silica particles is used within the claimed range and particle size of the inorganic particles is within the range disclosed in the present disclosure. Therefore, it is examiner's position that the porosity and opacity would be substantially inherently present within the claimed ranges as the same materials and the same stretching approach have been employed. Like material has like property. The recitation "an in-mold-forming label" or "a resin container" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on

the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Accordingly, Hatke anticipates or strongly suggests the claimed subject matter.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HV



HAI VO
PRIMARY EXAMINER